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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MILES & STOCKBRIDGE PC			SAGER, MARK ALAN	
1751 PINNACLE DRIVE				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/725,580	DAYAN, MARCEL
	Examiner	Art Unit
	M. A. Sager	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 February 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-7 and 9-15 is/are rejected.
 7) Claim(s) 8 and 16 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Powerball. The Powerball webpage discloses that game was started in 1989 and the matrix has changed periodically such as shown in table under Playing the Game that on November 2, 1997, the matrix included pick five elements/balls of one out of forty-nine and a sixth ball/element of one out of forty-two and that two machines are used in the game where first machine draws five white balls and second machine draws one red ball where the balls are mixed by a turntable at bottom of machine that propels the balls around the chamber such that Powerball as played publicly at least since around November 2, 1997 teaches claimed method and apparatus including providing a mechanical ball draw machine to draw one ball at a time from a set of balls as stated under Machines Used, providing a set of balls to mechanical ball machine as white and red numbered balls, the set of balls consisting of a plurality of subsets of one or more balls (white balls numbered balls from one to forty-nine and red balls from one to forty-two so there is essentially two sets of numbered balls from one to forty-two and one set of numbered balls forty-three to forty-nine, sic), at least some of the subsets having different numbers of balls such as the sixth ball having range of one to forty two while white balls include range of numbers to forty-nine, each ball being identifiable as belonging to a subset as stated under Playing the Game of white numbered balls of a range of numbers and red numbered balls of a different smaller range

of numbers (sic), whereby the relative numbers of balls in the subsets determine the likelihood of a ball from a subset being drawn such that there is a higher chance of numbers one to forty two being selected between the red and white balls than numbered balls forty three through forty nine (implicit), a game controlling device to control drawing a ball or balls using mechanical ball machine until sufficient balls have been drawn to enable a result to be determined wherein a single number is drawn and a single subset is identified as stated under Playing the Game and Machines Used of selecting five white balls and one red ball whereby drawing six balls includes drawing a single ball and identification of subset is as explained next, identifying the subset to which each ball or balls belongs as stated above regarding selecting first five digits of lotto matrix from white numbered balls of a range of numbers and selecting a sixth red numbered ball of a smaller range of numbered balls and the corresponding number of associated white or red ball drawn is determined or identified, determining the result of electronic game from the identified subset or subsets as shown in table of matches and payoffs under Playing the Game where it is an electronic game in so far as the electronic recordation/reporting of player selected numbers that are compared to machine drawn numbers, wherein said game controlling device controls said mechanical ball draw machine to draw a plurality of balls whereby a plurality of different subsets are identified and the game controlling device determines the result on the basis of the order in which the balls corresponding to the subset are drawn in that white numbered balls from one to forty-nine are drawn first and a red numbered ball from one to forty-two is drawn to compare with player selected numbers for determining win such that the red numbered ball is always the in the order of being the last digit of matrix as shown in Playing the Game.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powerball. Although Powerball discusses using two ball draw machines, the first machine draws the five white numbered balls while the second machine draws a red numbered ball and thus appears to lack an additional mechanical ball machine so that there is a primary mechanical ball machine and a secondary mechanical ball machine, and drawing from both mechanical ball machines substantially simultaneously and using the subsets identified from said primary mechanical ball machine to determine the result unless the primary mechanical ball machine fails and using the subsets identified from said secondary mechanical ball machine to determine the result if the primary mechanical ball machine fails or an additional mechanical ball machines so that there is a primary mechanical ball machine and a secondary mechanical ball machine, and drawing from both mechanical ball machines substantially simultaneously and wherein the game

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controlling device uses the subsets identified from said primary mechanical ball machine to determine the result unless the primary mechanical ball machine fails and wherein the game controlling device uses the subsets identified from said secondary mechanical ball machine to determine the result if the primary mechanical ball machine fails. However, it is notoriously well known to an artisan at a time prior to the invention to do duplicate a part and its function as a back up such as in case of failure of primary part or device. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a “web” which lies in the joint, and a plurality of “ribs” projecting outwardly from each side of the web into one of the adjacent concrete slabs. The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.). Similarly, in this instance, no new or unexpected result is produced from duplication of the two mechanical ball draw machine(s) that is used in case of failure of primary ball draw machine(s). Thus it would have been obvious to an artisan at a time prior to the invention to add an additional mechanical ball machine so that there is a primary mechanical ball machine and a secondary mechanical ball machine, and drawing from both mechanical ball machines substantially simultaneously and using the subsets identified from said primary mechanical ball machine to determine the result unless the primary mechanical ball machine fails and using the subsets identified from said secondary mechanical ball machine to determine the result if the primary mechanical ball machine fails or an additional mechanical ball machines so

that there is a primary mechanical ball machine and a secondary mechanical ball machine, and drawing from both mechanical ball machines substantially simultaneously and wherein the game controlling device uses the subsets identified from said primary mechanical ball machine to determine the result unless the primary mechanical ball machine fails and wherein the game controlling device uses the subsets identified from said secondary mechanical ball machine to determine the result if the primary mechanical ball machine fails as known for duplication to have back-up in case primary unit fails to function properly as known to duplicate parts to Powerball game to have back up in case of failure by primary unit.

6. Claims 1-6 and 9-14 are rejected under 35 U.S.C. 102(b) as anticipated by Markowicz (5938200) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Markowicz (5938200) in view of Imperato (3560127). Where some of the subsets having different numbers of balls is resultant from a prior draw (4:46-62), Markowicz discloses a method and apparatus (1:35-3:20, figs. 1-6) comprising providing a mechanical ball draw machine configured to draw one ball at a time from a set of balls (4:35-37), providing a set of balls to said mechanical ball machine (4:3-12), said set of balls consisting of a plurality of subsets of one or more balls (3:40-4:5), at least some of the subsets having different numbers of balls such as after a draw of numbered element (4:35-62) and each ball being identifiable as belonging to a subset (4:3-4, 6:9-12), whereby the relative numbers of balls in the subsets determine the likelihood of a ball from a subset being drawn thus allowing fixed odds betting to be carried out on a result determined on the basis of subset identity (4:54-62), a game controlling device to control said ball drawing machine for drawing a ball or balls using said mechanical ball machine until sufficient balls have been drawn to enable a result to be determined wherein a single ball is drawn and a single subset is identified

or a plurality of balls are drawn and a plurality of subsets are identified and the game result is also determined on the basis of the order in which the balls corresponding to the subset are drawn and wherein balls are drawn until three different subsets are identified (4:35-37, 5:10-14, 6:9-12, 6:16-34), identifying the subset to which each said ball or balls belongs (4:4-5), determining the result of said electronic game from the identified subset or subsets (6:9-34), wherein said electronic game involves a race having a plurality of participants each of which are allocated one of said subsets of balls and wherein determining the result involves allocating first position in the race to the participant corresponding to the first subset identified or wherein said electronic game involves a race having a plurality of participants each of which are allocated one of said subsets of balls, and wherein determining the result involves allocating first position in the race to the participant corresponding to the first subset identified, second position to the participant corresponding to the second subset which is identified, and third position to the third participant corresponding to the third subset which is identified (fig. 1-2, 6).

Alternatively, where some of the subsets having different number of balls refers to numbers of balls at start and prior to drawing a ball (not currently claimed or as limiting to such), Markowicz discloses claimed method but includes same number of balls for each participant at start or prior to initial draw thereby lacking same number of balls for each participant since Markowicz provides same number of balls for each participant (4:5-12). In a similar race simulation game, Imperato discloses weighting the likelihood of a participant progressing in a race by providing different number of indicia being selected for each participant (2:23-34) which although Imperato discusses use of five die each having six faces with a number of faces associated with each racing participant a different number of times on a representative proportion

of the thirty faces of the five die that is similar to thirty objects being selected with the stated number of objects for each participant represented to provide weighted odds for each participant. For instance, Imperato states participant one has six identified and associated faces which is equivalent to participant one having six associated and identifiable objects out of thirty objects where the remaining twenty-four objects are identifiable and associated according to the stated number of faces. This is analogous to odds of participants in racing in reality whether dog, horse, auto or other participant in a field of participants generally are not wagered in a manner of uniformity in that generally each participant is weighted or has associated odds of winning based on their ability and thus each participant is weighted differently. Thus, it would have been obvious to an artisan at a time prior to the invention to add same number of balls for each participant as suggested by Imperato to Markowicz to permit a simulation of real racing whereby racing participants are weighted based on ability such that a skilled race participant is weighted in favor of winning over a less skilled race participant. The added realism increases player interest and the weighting of racing participants in a non-uniform distribution adds a level of strategy not present in a system having uniform distribution that also may increase player interest.

7. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowicz or over Markowicz in view of Imperato. Markowicz or Markowicz in view of Imperato discloses claimed method except an additional mechanical ball machine so that there is a primary mechanical ball machine and a secondary mechanical ball machine, and drawing from both mechanical ball machines substantially simultaneously and using the subsets identified from said primary mechanical ball machine to determine the result unless the primary mechanical ball

machine fails. However, it is notoriously well known to an artisan at a time prior to the invention to do duplicate a part and its function as a back up such as in case of failure of primary part or device. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a "web" which lies in the joint, and a plurality of "ribs" projecting outwardly from each side of the web into one of the adjacent concrete slabs. The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.). Similarly, in this application, no new or unexpected result is produced from duplication of the mechanical ball draw machine used in case of failure of primary ball draw machine. Thus it would have been obvious to an artisan at a time prior to the invention to add an additional mechanical ball machine so that there is a primary mechanical ball machine and a secondary mechanical ball machine, and drawing from both mechanical ball machines substantially simultaneously and using the subsets identified from said primary mechanical ball machine to determine the result unless the primary mechanical ball machine fails and using the subsets identified from said secondary mechanical ball machine to determine the result if the primary mechanical ball machine fails or an additional mechanical ball machines so that there is a primary mechanical ball machine and a secondary mechanical ball machine, and drawing from both mechanical ball machines substantially simultaneously and wherein the game controlling device uses the subsets identified from said primary mechanical ball machine to determine the result unless the primary mechanical ball machine fails and

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wherein the game controlling device uses the subsets identified from said secondary mechanical ball machine to determine the result if the primary mechanical ball machine fails as known for duplication to have back-up in case primary unit fails to function properly as known to duplicate parts to Markowicz or to Markowicz in view of Imperato to have a backup unit in case of failure.

Allowable Subject Matter

8. Claim 8 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: prior art does not teach/suggest using subset identified by whichever mechanical ball machine first produces the required number of different subset identities to determine the result in conjunction with other claimed steps/features since Powerball and Markowicz appear to include public display of draw and although it may be obvious to provide a backup draw machine the using of subset identified by whichever machine first produces the required number of different subset identities from simultaneous draws by separate machines may cause confusion and unnecessary public ire from a second different ‘public’ result.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



M. A. Sager
Primary Examiner
Art Unit 3714

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